

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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METHOD FOR ACCESSING EMAIL ATTACHMENTS
FROM A MOBILE VEHICLE

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Group Art Unit: 2455

Examiner: Hamza, Faruk

Attorney Docket No. GP-304074-OST-ALS

REPLY BRIEF

Board of Patent Appeals and Interference
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Reply Brief is being filed to respond to certain comments and assertions contained in Section (10) of the Examiner's Answer mailed March 5, 2009. Appellants respectfully submit that the analysis and conclusions as to the different rejections are incorrect and therefore requests Board action to overturn the rejections.

§103 Rejections

Claims 1-3, 8-10, and 15-17— Obviousness in view of Sharif and Bastian

On page 9 of the Answer, the Examiner addresses a primary distinction over the art that was discussed in the Second Appeal Brief; namely, that neither reference teaches

or otherwise renders obvious the classification and routing of email attachments at a vehicle or other client device. However, the Examiner seems to misunderstand this distinction and, in doing so, overlooks the fact that neither reference teaches or suggests classifying and routing an email attachment at any client device, much less a vehicle. In particular, the Examiner notes that Appellants' claims refer to classification at the vehicle, not "at the client device." This is true, but seems to ignore the fact that the vehicle is akin to a client device, as opposed to a remote server. That is, both Appellants' disclosed system and the applied prior art systems utilize both a remote server and some type of end-user client device. In Sharif, the remote server is just that - a remote (UNIQA) server 1908 that communicates with the various remotely-located client devices (Internet appliances) 1910-1914. In Appellants' disclosed system, the remote server is at the web-hosting portal 160 or call center 170, and it communicates with the various remotely located vehicles 110 which are, in essence, client devices that permit users to interact with email downloaded to the vehicle from the call center. This is evident to those skilled in the art.

In Sharif, the processing of the email all occurs at the remote server. This is discussed in detail on page 8 of the Second Appeal Brief. In Bastian, processing also occurs at a central server, not at the vehicle, and it teaches doing so specifically to avoid the necessity of sending relatively large attachments to the vehicle. Thus, the Examiner wrongly concludes that Sharif and Bastian together teach "identifying email attachment type at the aircraft."¹ They do not so teach, but, to the contrary, both would lead one of ordinary skill in the art to perform such processing only at the remote server. In this regard, the Examiner has provided no proper basis or rationale as to why one of ordinary skill in the art would ignore the references' teachings of the processing at the remote server, and ignore or otherwise discount the reasons why these references do so at the remote server, and instead classify and route attachments at a vehicle, as claimed by Appellants.

Thus, even if a person of ordinary skill combined the teachings of Sharif with those of Bastian, that person would not arrive at Appellants' claimed subject matter. As

¹ Examiner's Answer, March 5, 2009, page 10, lines 11-12

one specific example, consider if the server taught by Sharif is utilized in connection with an aircraft as taught by Bastian. In such a combined system, the server taught by Sharif would be placed at a base station, not on an aircraft. More precisely, if one attempted to incorporate Sharif's server into Bastian's aircraft itself, the combination would contradict the teachings of Bastian, specifically "prevent[ing] large attachments...to email messages from being sent across the relatively low bandwidth link between the base station and the server."² Placing the server of Sharif on an aircraft for processing therein would involve sending all email attachments over the low bandwidth link, a process Bastian explicitly avoids. Rather, if one incorporated the server taught by Sharif into Bastian's system it would be located at a base station taught by Bastian which is entirely consistent with Sharif's own teaching of processing at its UNIQA server. And in that case, the base station is located on the ground—not on a vehicle. A similar result occurs if Bastian's system is used to modify Sharif's.

Claims 4, 11, and 18—Combination of Sharif, Bastian, and Lazaridis

The Examiner misstates or misunderstands Appellants' argument. Page 10 of the Second Appeal Brief does not state that "there is no motivation to combine Lazaridis with Sharif and Bastian."³ Rather, Appellants argued that "the Examiner has not provided any proper basis for combining the references in any manner that renders the claims obvious."⁴ The main defect with the Examiner's response is that it focuses on the basis for combining references, and not on the fundamental problem with the combination; namely, that it still does not render obvious the subject matter claimed by Appellants. As noted in Appellants' response filed April 18, 2007, and in the First and Second Appeal Briefs, Lazaridis does not teach determining a classification of an attachment at a vehicle or mobile device, nor does it suggest doing so since one of the objectives of Lazaridis is to avoid sending attachments to the mobile device that it cannot process and present to the user. Thus, it does not make up for the deficiencies of the Sharif-Bastian combination because it still would not result in the claimed email attachment processing occurring at a vehicle or other client device.

² Bastian, U.S. Patent No. 6,757,712, col. 5, lines 29-32.

³ Examiner's Answer, page 10, lines 14-15.

Claims 6-7, 13-14, and 20-21—Combination of Sharif, Bastian, and Ban

Again, the Examiner has misstated Appellants' argument in that Appellants did not argue that there is no motivation to combine, but rather that the Examiner has not identified a proper basis to combine; in particular, that the Examiner has not identified any teaching from Ban that would lead one of ordinary skill in the art to combine its teaching with Sharif and Bastian and abandon those references' teachings of the processing of attachments at a central server. Thus, no *prima facie* case of obviousness has been made out.

Claims 5, 12, and 19—Combination of Sharif, Bastian, Lazaridis, and Official Notice

Here as well the Examiner appears to misunderstand Appellants' argument. Appellants' point is not that the Examiner needs to support his Official Notice with documentary evidence, but that Official Notice is not appropriate for Appellants' claim limitation of "setting a bit in a random access memory of the mobile vehicle telematics unit and thereby routing the email attachment to one of the audio unit or the display screen." As stated in the MPEP §2144.03, "the notice of facts beyond the record which may be taken by the Examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.'"⁵ The above-quoted limitation from Appellants' claims 5, 12, and 19 is not such a fact. Examples of properly taken Official Notice include adjusting the intensity of a flame in accordance with a heat requirement and other such facts that are capable of instant and unquestionable demonstration. Without having properly established that the claim limitation is merely one such fact, the Examiner is able to deny patentability without establishing a *prima facie* case of obviousness. And as noted in the Second Appeal Brief, the Examiner's focus only on "setting a bit in a random access memory" ignores the remaining limitation of these claims that indicates that the routing is dependent on the setting of the bit—a limitation that Appellants' assert is not well known in the art.

⁴ Second Appeal Brief, page 10, lines 16-18.

⁵ *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)

Furthermore, not only should Official Notice not have been taken, but even if it were proper the evidence cited by the Examiner supporting that notice fails the adequate evidence test set forth in the MPEP. Providing support for the Official Notice, the Examiner cites Garg et al. (U.S. Patent No. 6,862,630) column 6, lines 24-30. But simply citing Garg does not meet the adequate evidence standard set forth in the MPEP. In particular, MPEP §2144.03 states that if an Applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the Examiner must support the finding with adequate evidence. The Federal Circuit Court addressed the standard of adequate evidence in *In re Zurko* stating that:

with respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience—or in its assessment of what would be basic knowledge or common sense. Rather, the board must point to some concrete evidence in the record in support of these findings.⁶

The section cited by the Examiner contains no evidence, concrete or otherwise, establishing that setting a bit in the memory of a register is basic knowledge or common sense. Generally, the cited section of Garg states, *inter alia*, that a “frame buffer management circuit 100 also sets a bit in the register 106 corresponding to the priority level.”⁷ However, the Garg reference fails to provide concrete evidence that setting a bit in the memory or register is basic knowledge or common sense. As a result, the Examiner cannot simply rely on Official Notice to deny patentability. Rather, if the Examiner wishes to maintain his existing rejection of claims 5, 12, and 19, he must make a *prima facie* case of obviousness under §103(a) incorporating the Garg reference with the cited combination of Sharif, Bastian, and Lazaridis. This has not been done and Appellants respectfully submit that no such proper rejection can be made on the basis of these references.

Conclusion

In view of the foregoing, Appellants respectfully request that the Board overturn the Examiner's rejections of all claims and direct that they be allowed over the applied

⁶ *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)

⁷ Garg et al, U.S. Patent No. 6,862,630, col. 6, lines 28-30.

prior art.

The Commissioner is authorized to charge any fees, or refund any overpayments, associated with this Reply Brief to Deposit Account No. 07-0960.

Respectfully submitted,

REISING ETHINGTON P.C.

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